



AF
JFW

Docket No.: TEI-0122
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ieyasu Kobayashi et al.

Application No.: 09/914,033

Confirmation No.: 8235

Filed: August 22, 2001

Art Unit: 3654

For: POLYESTER FILM ROLL

Examiner: W. A. Rivera

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Reply Brief under 37 C.F.R. §41.41 in response to the Examiner's Answer mailed on October 2, 2007.

Because December 2, 2007, two months after the mailing date of the Examiner's Answer, falls on a Sunday, the period for response is extended to December 3, 2007, which is the next day that is neither a Saturday, Sunday nor a Federal holiday in the District of Columbia.

All arguments presented within the Appeal Brief of September 5, 2006 are incorporated herein by reference. Additional arguments are provided hereinbelow.

Claims 1-24 are currently pending in this application, with claims 1 and 16 being independent. No claims have been allowed.

Page 2 of the Final Office Action of August 10, 2004 indicates a rejection of claims 1-3 and 16-18 under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent No. 4,576,344 to Sasaki et al. (Sasaki).

Page 2 of the Final Office Action of August 10, 2004 indicates a rejection of claims 4-15 and 19-24 under 35 U.S.C. §103 as allegedly being unpatentable over Sasaki.

Among others, the following positions were presented in the Examiner's Answer, each of which will be addressed in turn in this Reply Brief:

ARGUMENT

Claims 1-15 - Claims 2-15 are dependent upon claim 1. Claim 1 is drawn to a polyester film roll in which a polyester film is rolled on a core,

said polyester film roll having a maximum diameter and a minimum diameter when all diameters of said roll are measured along the width direction of the roll, and

the difference R between the maximum diameter value and the minimum diameter value is not more than $2W \times 10^{-3}$ and not more than $L \times 10^{-7}$,

wherein W is the width of the film roll, and L is the length of the rolled film.

Sasaki arguably teaches that, however, when the diameter of the resultant film roll becomes large, it is difficult to keep the pressure applied the surface of the film roll constant because of deviation in load on the rotation drum, which deviation in load is derived from a disturbance which cannot be controlled (Sasaki at column 2, lines 33-39).

Yet, the Examiner's Answer fails to show where within Sasaki that the teaching of a maximum diameter and a minimum diameter can be found.

Instead, the Examiner's Answer offers that *in the instant case, it should be noted that Sasaki et al do teach maximum and minimum diameters because all circular articles have diameters* (Examiner's Answer at page 4).

In response, the Examiner's Answer fails to highlight any teaching within Sasaki regarding the difference R between the maximum diameter value and the minimum diameter value not being more than $2W \times 10^3$ and not more than $L \times 10^7$.

Nevertheless, the Examiner's Answer further contends that the only difference is that in the Sasaki et al reference the difference between the maximum and minimum diameters equal zero (Examiner's Answer at page 4).

In response, the Examiner's Answer fails to highlight any teaching within Sasaki regarding the maximum and minimum diameters being equal to zero.

In this regard, Sasaki arguably teaches that the film was cut a width of 650 mm and wound up by means of a slit-winding machine at a winding speed of 150 m/min to form a film roll having a roll length of 6,000 meters (Sasaki at column 8, line 68 to column 9, line 3).

Sasaki arguably teaches that a polyester film having a thickness of 10 microns and a centerline average surface roughness of 0.025 microns was slit and wound by means of a slit-center-winding machine to form a film roll having a width of 650 mm and a roll length of 5,000 m (Sasaki at column 9, lines 23-27).

Here, the Examiner's Answer fails to identify any relationship within Sasaki between:

- 1) The diameter of the polyester film roll;***
- 2) The width of the film roll; and***
- 3) The length of the rolled film.***

As a result, the Examiner's Answer fails to highlight any teaching within Sasaki regarding the difference R between the maximum diameter value and the minimum diameter value is not more than $2W \times 10^{-3}$ and not more than $L \times 10^{-7}$, wherein W is the width of the film roll, and L is the length of the rolled film.

To account for these deficiencies within Sasaki, page 5 of the Examiner's Answer concludes, without providing any supporting evidence, that it is well known in the art, and intuitively apparent, that a wrinkle free roll would have a uniform diameter along its width.

Intuitively apparent - Regarding the assertions made within the Examiner's Answer of what is allegedly "intuitively apparent", please note that the Courts have not upheld arguments based on 'inherent' properties when there is no supporting teaching in the prior art" (emphasis added). *In re Dillon*, 13 USPQ2d 1337, 1348 (Fed. Cir. 1989). Instead, the Office Action must provide rationale or evidence tending to show inherency. M.P.E.P. §2112(IV).

The mere fact that a certain thing may result from a given set of circumstances is not sufficient to show an inherent anticipation. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Specifically, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Instead, inherency requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

Well known - Regarding the assertions made within the Examiner's Answer of what is allegedly "well known", please note that "assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference." (Citations omitted). *In*

re Pardo and Landau, 214 USPQ 673, 677 (CCPA 1982). The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

“Allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

Moreover, the procedures established by Title 37 of the Code of Federal Regulations expressly entitle the Applicant to an Examiner’s affidavit upon request. Specifically, “when a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.” 37 C.F.R. §1.104(d) (2).

Accordingly, Applicant hereby requests a reference or an Examiner’s affidavit to support this officially noticed position of obviousness or what is well known.

Further, note that if this reference or Examiner’s affidavit is not provided, the assertions of what is well known must be withdrawn. See M.P.E.P. §2144.03.

Also, note that the *failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error*. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

However, these contentions of “inherency” and what is “well-known” are merely a personal conclusion that is unsupported by any objective evidence.

- *Thus, the Examiner's Answer fails to highlight a teaching within Sasaki that the difference R between the maximum diameter value and the minimum diameter value is not more than $2W \times 10^3$ and not more than $L \times 10^7$, wherein W is the width of the film roll, and L is the length of the rolled film.*

The Examiner's Answer challenges that *if it is still the appellant's position that Sasaki does not meet the limitation, then applicant must provide factual evidence, such as test results, as to why Sasaki et al do not meet the claim* (Examiner's Answer at page 5).

In response, Table 1 of the specification as originally filed is provided hereinbelow.

TABLE 1

	Roll					The Rolled Appearance of the Roll	
						At the	
	W [m]	L [m]	$2W \times 10^{-3}$ [10^{-6} m]	$L \times 10^{-7}$ [10^{-6} m]	R [10^{-6} m]	Just after Slit	Passage of 24 hours after Slit
Example 1	0.500	9,000	1,000	900	300	Very good	Very good
Example 2	0.620	7,000	1,240	700	220	Very good	Very good
Example 3	0.500	9,000	1,000	900	250	Very good	Very good
Example 4	0.500	9,000	1,000	900	350	Very good	Very good
Comparative Example 1	0.500	9,000	1,000	900	1,200	Bad	Bad
Comparative Example 2	0.620	7,000	1,240	700	810	Bad	Bad
Comparative Example 3	0.500	7,000	1,000	700	950	Bad	Bad
Comparative Example 4	0.500	9,000	1,000	900	1,030	Good	Bad

Accordingly, at least Table 1 of the specification as originally filed provides factual evidence, such as test results, as to why Sasaki et al do not meet the claim.

Claims 16-24 - Claims 17-24 are dependent upon claim 16. Claim 16 is drawn to a polyester film roll in which a polyester film is rolled on a core,

said polyester film roll having a plurality of diameters obtained from measurements along the width direction of the roll,

said plurality of diameters being represented by a curved line having two ends,

said plurality of diameters comprising a maximum diameter and a minimum diameter,

said maximum diameter being represented by

a first maximum perpendicular line length which is determined by a straight line drawn connecting both ends of the curved line, and

a first perpendicular line with respect to said straight line drawn from the maximum convex area of said curved line to said straight line,

said minimum diameter being represented by

a second maximum perpendicular line length which is determined by a second perpendicular line with respect to said straight line drawn from the maximum concave area of said curved line to said straight line,

wherein the first maximum perpendicular line length is not more than 500 μm , and the second maximum perpendicular line length is not more than 300 μm .

The Examiner's Answer contends that *with respect to the limitation "wherein the first maximum perpendicular line length is not more than 300 micro-meters", it should be noted that it appears that appellants are claiming the graph shown in Figure 6* (Examiner's Answer at page 5).

As an initial matter, **no Figure 6** can be found within Sasaki.

Moreover, the claim language is both clear and unambiguous. Included within claim 16 is a polyester film roll, wherein the first maximum perpendicular line length is not more than 500 μm , and the second maximum perpendicular line length is not more than 300 μm . The attempted reconstruction made within the Examiner's Answer is merely an attempt to redefine the invention in a manner different than from what is disclosed within the specification and set forth within the claims. Such an attempted reconstruction is without authority under Title 35 U.S.C., Title 37 C.F.R., the M.P.E.P. and relevant case law; such an attempted reconstruction is therefore deemed improper and inappropriate. See M.P.E.P. §2164.08.

The Examiner's Answer considers claim 16 to be a product-by-process claim (Examiner's Answer at page 5).

In response, an applicant for patent is entitled to select the claim language as long as the meaning is reasonably plain and specific. *Ellipse Corporation v. Ford Motor Company*, 312 F.Supp. 646, 660, 164 USPQ 161, 171 (N.D. Ill. 1969). The plain meaning of claims language is entitled to a strong presumption that it correctly expresses the scope of the claim. *In re Certain Thermometer Sheath Packages*, 205 USPQ 932, 941 (ITC 1979).

A "product-by-process" claim is one in which the product is defined at least in part in terms of the method or process by which it is made. *Atlantic Thermoplastics Co. Inc. v. Faytex Corp.*, 970 F.2d 834, 23 USPQ2d 1481 (Fed. Cir. 1992).

Nevertheless, even words of limitation that can connote with equal force a structural characteristic of the product or a process of manufacture are commonly and by default interpreted in their structural sense, unless the patentee has demonstrated otherwise. *3M Innovative Properties Co. v. Avery Dennison Corp.*, 69 USPQ2d 1050, 1054 (Fed. Cir. 2003).

However, read in context, the feature of "*wherein the first maximum perpendicular line length is not more than 500 μm , and the second maximum perpendicular line length is not more*

than 300 μm ” is not described by a process used to obtain it. Instead, the feature is physical characteristic of a structure. **Physical characteristics are not process steps.**

Exclusion of any claimed feature from consideration is also deemed improper. *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)(Board erred by denying patentable weight to data structure limitations). As a result, the mischaracterization of “wherein the first maximum perpendicular line length is not more than 500 μm , and the second maximum perpendicular line length is not more than 300 μm ” as product-by-process feature, along with an exclusion of this feature from consideration, is improper.

In response, the Examiner’s Answer admits that Sasaki does not mention the specific dimensions in term of rolling hardness or flexural modulus etc. (Examiner’s Answer at page 4).

As a result, the Examiner’s Answer fails to show all claimed features as being present within Sasaki.

To account for the features that are admittedly deficient from within Sasaki, the Examiner’s Answer contends that, it would have been an obvious matter of design choice, as determined through routine experimentation and optimization, to dimension the polyester film roll of Sasaki et al as specified in Claims 4-15 and 19-24 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use (Examiner’s Answer at page 4).

In response, this unsupported contention amounts to nothing more than a personal conclusion that is unsupported by any objective evidence. Note that the teachings, suggestions, or incentives supporting the obviousness-type rejection must be clear and particular. Broad conclusory statements, standing alone, are not evidence. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

As a result, the use of “design choice” made within the Examiner’s Answer is improper. See *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1995) (“design choice” rejection reversed). See also *In*

re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999) (“design choice” rejection reversed, reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the prior art taught or suggested the claimed invention).

RELATED PROCEEDINGS

There is currently an appeal proceeding in Application Serial No. 10/832,279 that may have a bearing on the Board’s decision in this appeal.

CONCLUSION

There is no concession as to the veracity of Official Notice, if taken in any Office Action. An affidavit or document should be provided in support of any Official Notice taken. 37 CFR 1.104(d)(2), MPEP § 2144.03. See also, *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989)(failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error).

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance.

The prior art of record fails to disclose, teach or suggest all the features of the claimed invention.

For at least the reasons set forth hereinabove, the rejection of the claimed invention should not be sustained.

Therefore, a reversal of the rejection of August 10, 2004 is respectfully requested.

If any additional fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: December 3, 2007

Respectfully submitted,

By 

Brian K. Dutton

Registration No.: 47,255

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 23353

Attorney for Applicant